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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,323	07/24/2003	William A. Miller	29891/FMP0385	1330
4743	7590	10/12/2005	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			SOOHOO, TONY GLEN	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,323

Applicant(s)

MILLER, WILLIAM A.

Examiner

Tony G. Soohoo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the original specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. for the second base suspension being "non-colorant" suspensions, does not reasonably provide enablement for "free of colorant" of the second base material.

It is noted that the use of titanium dioxide is a colorant of white in color.

Claim interpretation

The description of the 2nd base material is being read by the examiner, for examination purposes as a non-colorant suspension as supported by the original specification.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/15735 (Unilever WO '735) in view of Miller 6767126.

WO 02/15735 (Unilever WO '773) discloses:

a method of mixing a cosmetic preparation at a point of sale (see abstract),

comprising:

providing a container,

adding a first base suspension (page 4, lines 7-8) whose width of volume would inherently cover the bottom of the container and its height of the volume would thereby coat a lower portion of the sidewall of the container, colorant free 1st base suspensions are described on page 5, lines 29 through page 6, last line.

adding one or more suspensions comprising one or more colorants on top of the first base suspension (page 4, lines 9-10, it is noted that the performance agent can be a colorant, see page 8, lines 18-19), colorants are described on page 8 lines 18-19.

adding a second base suspension with of the colorants (page 4, lines 19-24, noting that the second class of performance agents, or the second vehicle in which they are delivered is considered as the second base suspension), non-colorant performance agents are described on page 7, lines 24-16.

dosing the product into a container,

closing the container lid with a plug in the neck of the container, (page 10, lines 4-5) and mixing the product until it is uniform (page 5, lines 5-6), and to use a device mixer with twin axis movement, (page 10, lines 10-17).

The UNILEVER WO '735 discloses all of the recited subject matter as defined within the scope of the claims with the exception of the issues of

1) the number of material suspensions added in the mixture, in particular, the number of colorant suspensions and number of colorant-free suspensions, and,

2) the ordering of the addition of colorant-free base suspensions as a 1st step and last step of a non-colorant suspension in order to sandwich the intermediate colorant additive suspensions prior to closing the container and mixing step, and

3) the application of mechanical energy to the closed container, and in further use of an arrangement of a particular to a gyroscopic intersecting axes.

With regards to the 1st Issue (1), in particular to the number of colorant-free base suspensions and colorant suspensions, such materials of colorant-free base suspensions are old and well known in the cosmetic art. Examples of commonly known different colorant-free base suspensions in the art of cosmetics are; water with emulsifiers, glycerin with emulsifiers, and oils with emulsifiers. These base suspensions, provide such properties of volume, gloss or sheen, texture, viscosity, and skin feel which are mixed together in as an emulsion. It is further known in the art of cosmetics to provide combinations of colorant-free base suspension.

Also, examples of different color colorant suspensions are old and well known in the art of cosmetics. It is an old and well known technique color science in the cosmetic art to mix different colorants (otherwise known as tints as referred to by a common painter) to produce a final color.

Thus, with regards to the number of material suspensions added in the mixture, in particular, the number of colorant suspensions and number of colorant-free suspensions, it is deemed that it would have been obvious to one of ordinary skill in the art to provide, for the UNILEVER WO '735, any number of base suspensions of water with emulsifiers, glycerin with emulsifiers, or oils with emulsifiers, which are mixed together in as an emulsion in order to produce a desired effect of the properties of fluid volume, gloss or sheen, texture, viscosity, and skin feel. And furthermore, it is deemed that it would have been obvious to one of ordinary skill in the art to provide, for the UNILEVER WO '735 method, any number of colorant suspensions in order to tint the mixture to a desired color, whereby the number of tint and colorant free base suspensions are merely a duplication of essential known parts of a composition recipe to produce a desired cosmetic composition effect. Since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. St. Regis Paper Co. v. Bemis Co., 193 USPQ 8,

Thereby, it is deemed that absent any unexpected results, a choice of the number colorant-free suspension and number of colorant suspension would have been obvious to a person having ordinary skill in the art to choose and add any additional

steps of adding base and colorant tint produce the desired cosmetic tint or effect components.

With regards to the particular step of the 2nd issue, in particular, the particular ordering of the addition of colorant-free base suspensions as a sandwiching step with that of colorant additive suspensions steps, absent any unexpected results such as a reduction in mixing times, it is deemed that it would have been obvious to one of ordinary skill in the art to add without undue experimentation to add the materials of base suspensions of water with emulsifiers, glycerin with emulsifiers, or oils with emulsifiers, which are mixed together, any number of colorant suspensions in order to tint the mixture to a desired color. The reference teaches the addition of non-colorant materials such as), non-colorant performance agents are described on page 7, lines 24-16.

As long as the final mixing step of the mixing of the suspensions is provided effectively, any manner in the addition or layering of the suspension steps has been fully considered and deemed insignificant so long as that the final step of mixing the suspension provides a homogenous blend. The order of placement of the materials into the vessel to be mixed in the final step is nothing more than a rearranging of the parts of the element of the introduction of material into the vessel. It has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70., It is further noted that during the mixing step of the UNILEVER WO '735, should streaking appear, the final mixing step would not have been completed and thus

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the final mixing step must proceed further until all of the suspensions are fully mixed without any streaking. When that occurs, the final step as required by the UNILEVER WO '735 reference is complete, thus at the final step of the method, the final product of the mixed material of UNILEVER WO '735 would no more differ from that of a product which has a different dispensing sequence as claimed in the instant application.

With regards issue 3) to the mixing of the container with mechanical energy, the reference to Miller (6767126 with a filing date of March 19, 2002) discloses a gyroscopic mixing device which has a holder sleeve 22, 22a which may hold various container sizes (not shown). Miller teaches that this mechanical device may be useful in particularly a cosmetic and paint operation, column 3, lines 61-64.

Thus the reference to Miller brings out a motivation to mix a container of cosmetic with a manipulation of the use of a mechanical gyroscopic type dual axis of rotation mixer, as shown by Miller.

Therefore, in application of the Miller reference and suggestion that a gyroscopic mixer may be used in mixing cosmetic containers, and in view of the common knowledge of the need of mixing containers to be covered with a lid when placed in a mixing machine to prevent spillage, it is deemed that it would have been obvious to one of ordinary skill in the art to provide the manipulative step of the UNILEVER WO '735 reference with the additional steps of plugging the container with a lid, and mixing the mixture by the use of a gyroscopic mixer as suggested by the Miller reference in order to produce a more homogenous blend of the cosmetic product.

Response to Arguments

5. Applicant's arguments filed 4-13-2005 have been fully considered but they are not persuasive. Applicant has newly amended the claim to further point out that the step of the addition of each base suspension is a colorant-free base suspension thereby presenting a particular order of an a sandwiching step of the addition of colorant-free suspension with that of a colorant suspension. Applicant argues that The Unilever WO '735 reference does not teach or suggest the particular order. Applicant argues that such a dispensing sequence as claimed would reduce streaking in a clear container.

6. In response Applicant is directed to the detailed rejection and rationale made above addressing the issues with regards to the Unilever WO '735 reference.

7. With regards to the issue of streaks during mixing, it is applicant's burden to demonstrate unexpected results over the closest prior art by the effects of the order of introduction of material into the container to be mixed. See MPEP 716.02, also 716.02 (a) –(g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious of both statistical and practical significance such as a difference in mixing times. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CPPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173, USPQ 356 (CPPA 1972). In the instant case, no data has been presented only arguments have been made.

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8. Applicant is reminded that the scope of the invention is directed to a method of mixing a material whose product in the final step yields a fully mixed suspension. The prior art also yields and desires a mixed suspension, as the final product.

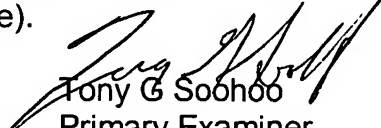
Applicants argument that an order of addition of material would may provide prevention of streaks upon a clear container, such an argument is immaterial to the instant claims since the claims do not claim issues of streaks in a clear container.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tony G. Soohoo whose telephone number is (571) 272 1147. The examiner can normally be reached on 7-5PM, Tue-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Tony G Soohoo
Primary Examiner
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